

REMARKS

Claims 1 - 38 are pending in this application. Claims 1 - 8 and 17 - 38 have been allowed by the Examiner.

As a preliminary matter, Applicant appreciates entry of Applicant's Amendment filed on 9 February 1995. In the Advisory action (Paper No. 21) mailed on 3 March 1995, the Examiner has, however, (1) objected the drawings because FIG. 3 was not labeled as "Prior Art"; (2) objected the Disclosure on the ground that the description of FIGs. 1 - 3 should have been placed in the "background of the invention" section as specified under MPEP §608.101(g); and (3) rejected claims 9 - 16 under 35 USC §112, second paragraph, for being indefinite.

With regard to the objection of the drawings because FIG. 3 was not labeled as "Prior Art." this requirement is actually improper. There is no requirement set forth in MPEP §608.02(g) mandating the labeling of FIG. 3 as "Prior Art." FIG. 3 does not itself constitute "Prior Art" as defined by either 35 USC §102 or 35 USC §103. Moreover, FIG. 3 is simply an abstract representation devised by Applicant in order to Applicant to explain the deficiencies in the "Prior Art"; as such, FIG. 3 is not "Prior Art." Accordingly, withdrawal is respectfully requested.

With regard to the objection of the disclosure because the description of FIGs. 1-3

regarding the conventional color video printer should be discussed in the "background of the invention" as is specified by MPEP §608.01(d), this objection is respectfully traversed as follows.

First, no rule under 37 CFR requires Applicant to specifically describe the detailed problems of the conventional color video printer in the "background of the invention" section. In fact, 37 CFR §1.77 simply requires an application to arrange in the order of: (a) Title of invention; (b) [Reserved]; (c) Cross-reference to related applications; (d) brief summary of the invention; (e) Brief description of the ... drawings, if there are drawings; (f) Detailed description. Detailed description is defined under 37 CFR §1.171(a) as:

"a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it most nearly connected, to make and use the same."

The description of detailed problems of the conventional color video printer is nothing more than a written description of the **discovery** of the source of the problems in the art, and is often in itself the invention. As is well known in patent practice, the solution to a problem, once known, may often be obvious even when the recognition of the problem itself or of the source of the problem is not. A patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. See *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 US 45 (1923); *In re Peehs*, 612 F.2d 1287, 204 USPQ 835 (CCPA 1980). For this reason, the detailed problems of the conventional

color video printer should be appropriately described in the detailed description of the invention, rather than the "background of the invention" as is asserted by the Examiner.

Second, while MPEP §608.01(d) prefers Applicant to describe the detailed problems of the prior art in the "background of the invention" section, Applicant is not mandated to follow the preference of MPEP. As a matter of law, the MPEP in itself, as is expressly stated in its Foreword, does not have the force of law or the force of the Patent Rules of Practice (37 CFR). The MPEP is simply a looseleaf training and instruction manual for examiners which is continually revised in piecemeal fashion and it is not surprising to find inconsistencies in it. See *Racing Strollers Inc. v. TRI Industries Inc.* 11 USPQ2d 1300 (CAFC 1989).

Accordingly, in view of the above reasons and the fact that all pending claims are in condition to be passed to issuance, Applicant respectfully requests the Examiner to withdraw this objection and pass the application to issuance without further examination on the merits.

With regard to the rejection of claims 9 – 16 under 35 U.S.C. §112, **second** paragraph, as being indefinite in several particulars, this rejection is actually without merit and is traversed as follows.

Specifically, in claim 1, the Examiner asserted that the term "columns" lacks proper antecedent basis. Actually, the term "columns" as defined in claim 1 is a definite article and is

first introduced in the claim. Consequently, there is no lack of proper antecedent basis as is asserted by the Examiner.

With regard to claims 9 and 10, these claims are perfectly clear and definite as are required under 35 USC §112, second paragraph. The Examiner is reminded that 35 USC §112, second paragraph empowers Applicant, not the Examiner, to distinctly claim the subject matter which Applicant, not the Examiner, regards as his invention. Specifically, 35 USC §112, *second* paragraph, expressly states:

"[T]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the **applicant regards as his invention**."

Further, 35 USC §112, *sixth* paragraph, also expressly mandates:

"An element in a claim for a combination may be expressed as a means or step for performing *a specified function without the recital of structure, material, or acts in support thereof*, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

Consequently, claims can be written by Applicant in any way as long as they particularly point out and distinctly claim the subject matter which Applicant regards as his invention as is expressly stated under 35 USC §112, **second** paragraph, even if written in a means-plus-function format as is expressly permitted under 35 USC §112, **sixth** paragraph.

For example, claim 9 can be written by Applicant to direct to "a high speed color video

printer" comprising:

"means for storing digital video signals in an internal memory as video data, reading a column unit of said video data stored in said internal memory ... and applying a field unit of said video data for a visual display providing a variable visual image ...

selection means for selectively providing one color of said video data from said column unit of said video data read from said internal memory ...

line memory means for storing said one color of said video data from said column unit of said video data provided from said selection means ...

means for enabling printing said one color of said video data from said column unit of said video data ... and

digital-to-analog converter means for converting said field unit of said video data into analog signals for enabling said visual display of said video data."

Similarly, claim 10 can be written by Applicant to direct to "a high speed color video

printer" comprising:

"**data conversion means** for storing said color video data in an internal memory, and for selectively reading said color video data stored in said internal memory in columns corresponding to pixels of a raster scan of an interlaced video field;

line memory means for storing said color video data selectively read from said internal memory in columns; and

printer means for column-by-column printing said color video data selectively read from said line memory means."

The Examiner has, however, asserted that the phrase "means for **storing** ... and **applying** ..." as

recited in claim 9, and the phrase "data conversion means for **storing** ... and selectively reading ..." as recited in claim 10 are indefinite because they are "not supported by recitation in the claim of sufficient structure to accomplish the function." This assertion is wholly in error both in law and in fact.

First, as stated above, both claims 9 and 10 are written in a means-plus-function format as is permitted under 35 USC §112, **sixth** paragraph. There is no need for Applicant to define sufficient structure in the claim to accomplish the function as is asserted by the Examiner. Consequently, "the recitation of more than one function for the data conversion means" does not make the structure indefinite because the claim simply does not specify or refer to the structure.

Second, Applicant is not obligated under 35 USC §112, **sixth** paragraph to specify what part of the "data conversion means" perform each of the two different functions of "storing said color video data in an internal memory" and "selectively reading said color video data stored in said internal memory." As mentioned earlier, 35 USC §112, **sixth** paragraph expressly mandates:

"An element in a claim for a combination may be expressed as a means or step for performing *a specified function without the recital of structure, material, or acts in support thereof*, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

The statute simply does not prohibit the drafter of claims to draft the "data conversion means" to perform only one specified function, but instead allows for a "*specified function without the*

recital of structure, material, or acts in support thereof." The specified function of the "data conversion means" as recited in claim 10 is again the "**storing** said color video data in an internal memory ... and **selectively reading** said color video data stored in said internal memory in columns corresponding to pixels of a raster scan of an interlaced video field." These two functions are clearly supported by the specification as part of the "data conversion means." Specifically, the Examiner's attention is directed to FIG. 6 where the detailed circuit configuration of the data conversion means is shown to comprise a plurality of memories 88a, 88b, 88c used to store different colors of the video data, and an output switch 86 used to selectively read the color video data stored in the memories 88a, 88b, 88c for subsequent storage in a line memory 68. Since the two functions of the "data conversion means" are fully supported by the specification, their recitation in claim 10 is entirely permissible within the purview of 35 USC §112, *sixth* paragraph.

To further demonstrate the practice of writing a single means in a means-plus-function format as comprising more than one function, the Examiner's attention is directed to *In re Kelley*, 134 USPQ 397, where the Court stated that:

"We see no reason why a single structural element....which performs two separate functions, cannot support a claim reciting broadly these separate functions,"

as long as the functions are different and are supported by the specification. See also *Palmer v. United States*, 163 USPQ 250. The vitality of *In re Kelley* is evident in the allowed claims in the cited U.S. Patent No. 5,291,313 issued to Kim, U.S. Patent No. 5,216,514 issued to Hong

et al., U.S. Patent No. 5,115,320 issued to Ebihara et al.

Specifically, the Examiner's attention is directed to the issued claim 1 of the Kim patent which requires "microcomputer means" to perform more than two functions (*i.e.*, **for calculating** an average value ... **for comparing** said average value with a predetermined value ... and for switchably connecting ...)

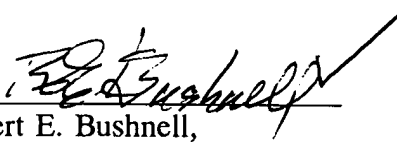
Similarly, claim 1 of the Hong patent also calls for "video processor means" for performing a first function, *i.e.*, "processing an input video signal" and for performing a second function, *i.e.*, "selectively generating an output"). Consequently, in view of the above, there is no statutory basis for the Examiner to maintain this rejection.

In sum, Applicant believes that all pending claims 1 – 38 are now in condition to be passed to issuance. All rejections under 35 USC §112, second paragraph, should be withdrawn.

No fee is incurred by this response since a Notice of Appeal was filed on 27 February 1995.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "R. E. Bushnell", is written over a horizontal line.

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